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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

BETIT, JACOB F

ART UNIT PAPER NUMBER

2164

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,369

Applicant(s)

NOGUCHI, TADASHI

Examiner

Jacob F. Betit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9, 11, 13, 15-20, 22, 24, 26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7, 9, 11, 13, 15-20, 22, 24, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 21 Apr 05 and 07 Jul 05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27-May-2005 has been entered.

Remarks

2. In response to communications filed on 27-May-2005, claims 2 and 15 are amended per applicant's request. Claims 2-7, 9, 11, 13, 15-20, 22, 24, 26, and 28 are presently pending in the application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-7, 9, 11, 13, 15-20, 22, 24, 26, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the first data" in line 5 and the limitation "the location" in line 11. There is insufficient antecedent basis for these limitations in the claim.

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Claims 2-7, 9, 11, and 13 are rejected for being dependent on rejected independent claim 2.

Claim 3 recites the limitation "the search conditions", in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the search conditions", in line 3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 11 and 24, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 13 recites the limitation "the user", in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the first search information" in line 6 and the limitation "the location" in line 10. There is insufficient antecedent basis for these limitations in the claim.

Claims 16-20, 22, 24, 26, and 28 are rejected for being dependent on rejected independent claim 15.

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Claim 16 recites the limitation “the search conditions”, in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation “the search conditions” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation “the time” in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation “the user” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-7, 13, 15-20, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Buchanan et al. (U.S. patent No. 5,267,155).

As to claim 2, Buchanan et al. teaches an information processing system (see column 2, lines 41-53) comprising:

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a search information storage module for storing first information for searching a database in association with identification information (see column 5, lines 13-17);

an identification information extracting module for extracting the identification information by scanning the first data to be used by application software (see column 5, lines 17-26);

a search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module (see column 5, lines 27-30);

a data extracting module for extracting second data by searching an external database on the basis of the extracted first search information (see column 5, lines 39-65 and see column 9, line 42 through column 10, line 13, where it is inherent that the relational database is external to at least some users); and

a data inserting module for inserting the extracted second data into the location from which the identification information of the first data has been extracted (see column 6, lines 34-50).

As to claim 15, Buchanan et al. teaches an information processing method (see column 2, lines 41-53) comprising:

an identification information extracting step of scanning first data to be used by application software, thereby extracting identification information (see column 5, lines 13-17);

a search information extracting step of referring to search information storage module for storing first information for searching a database in association with identification

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information, thereby extracting the first search information corresponding to the extracted identification information (see column 5, lines 17-30);

a data extracting step of searching an external database on the basis of the extracted first search information, thereby extracting second data (see column 5, lines 39-65 and see column 9, line 42 through column 10, line 13, where it is inherent that the relational database is external to at least some users); and

a data insertion step of inserting the extracted second data into the location from which the identification information of the first data has been extracted (see column 6, lines 34-50).

As to claims 3 and 16, Buchanan et al. teaches wherein the first search information at least includes information for specifying a database and information for specifying a part or all of the search conditions (see column 6, lines 34-46).

As to claims 4 and 17, Buchanan et al. teaches wherein the identification information extracting module extracts, in addition to the identification information, second information for searching a database, the second search information being located in association with the identification information, and the data extracting module searches a database on the basis of the first search information and the second search information (see column 6, lines 23-33).

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As to claims 5 and 18, Buchanan et al. teaches wherein the second search information at least includes information for specifying a part or all of the search conditions (see column 6, lines 23-33).

As to claims 6 and 19, Buchanan et al. teaches wherein the system can register or update the first search information with the search information storage module on the basis of user input (see column 4, line 33 through column 5, line 12).

As to claims 7 and 20, Buchanan et al. teaches wherein the search information storage module stores a plurality of the first search information by classifying it into a plurality of groups (see column 4, line 58 through column 5, line 12).

As to claims 13 and 26, Buchanan et al. teaches wherein at least any one of the inputs or outputs to the application software, database, or the user, is performed through a communication network (see column 10, lines 1-6).

As to claim 28, Buchanan et al. teaches a computer readable recording medium with a program stored therein for performing on a computer the information processing method according to claim 15 (the applicant is referred to the remarks and discussions made for claim 15

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above, where it is inherent that the method and system described would most commonly be preformed using a program stored on one or more hard disks in one or more computers; and see figure 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan et al. (U.S. patent No. 5,267,155) in view of Van Huben et al. (U.S. patent No. 6,327,594).

As to claims 9 and 22 Buchanan et al. does not teach wherein the application software is spreadsheet software and the first data is tabular data.

Van Huben et al. teaches a common access method that enables disparate pervasive computers to interact with centralized data management systems (see abstract), in which he teaches wherein the application software is spreadsheet software and the first data is tabular data (see column 25, lines 49-63).

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Buchanan et al. to include wherein the application software is spreadsheet software and the first data is tabular data.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Buchanan et al. by the teachings of Van Huben et al. because wherein the application software is spreadsheet software and the first data is tabular data would be a simple application that would provide tabular data format and perform sort and search operations on fields (see Van Huben et al., column 25, lines 58-63).

9. Claims 11 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan et al. (U.S. patent No. 5,267,155) in view of Salas et al. (U.S. patent No. 6,233,600 B1).

As to claims 11 and 24 Buchanan et al. does not teach wherein the application software is browser software and the first data is document data described in a structured tag language such as html.

Salas et al. teaches wherein the application software is browser software and the first data is document data described in a structured tag language such as html (see column 6, lines 40-56).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Buchanan et al. to include wherein the application software is browser software and the first data is document data described in a structured tag language such as html.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Buchanan et al. by the teachings of Salas et al. because wherein the application software is browser software and the first data is document data described in a structured tag language such as html would allow users to share files over time zones and geographic boundaries (see Salas et al., abstract).

Response to Arguments

10. Applicant's arguments filed 27-May-2005 have been fully considered but they are not persuasive.

In response to the applicant's arguments that Buchanan does not disclose several elements of claim 2, the arguments have been fully considered but are not deemed persuasive. The applicant is directed to the rejection of claim 2 for the references to the individual sections of Buchanan that teach these elements. The applicant appears to be making a blanket argument and does not explain why it is felt that these elements are not taught by the Buchanan reference. A general allegation that the claims define a patentable invention, without specifically pointing out how the language of the claims patentably distinguishes them over the references, is inadequate and is not in compliance with 37 CFR 1.111(b).

In response to the applicant's arguments that "the data extracting module extracts the 'second data' by searching an external database on the basis of extracted first search information, not the claimed 'identification information' and that "in Buchanan, the character strings

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(allegedly the 'second data') are obtained based on the variable identifiers (allegedly the 'identification information') themselves", the arguments have been fully considered but are not deemed persuasive. The examiner reads "identification information" as "variable identifiers" or "integer numbers surrounded by angle brackets". The "first search information corresponding to the extracted identification information" is read on the "integer numbers" that are actually used to find the "second data". The "angle brackets" are only used to identify that this is a hole in the document and not some number that is part of the text of the document. Searching for the "angle brackets" in the relational database would needlessly complicate the search algorithm because the "angle bracket" characters would be found in every search.

In response to the applicant's arguments that "Applicant has amended claim 2 to more clearly recite that the database is external and that a dedicated database is not required by the present invention", the arguments have been fully considered but are not deemed persuasive. The Applicant's assertion that Buchanan requires a "dedicated data file" is directed to only one embodiment of Buchanan. Further, limiting the applicant's invention to an "external database" does not mean limit the applicant's invention to a non-dedicated database. Buchanan teaches his database being used by more than one user and the database having user specific sections and shareable portions in at least one embodiment of his invention (see column 9, line 42 through column 10, line 6). It is inherent that the database would be external to at least one of the users if it is being shared among a plurality of users as described.

Conclusion

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Betit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

jfb
8 Aug 2005



**CHARLES RONES
PRIMARY EXAMINER**